

Despite the Examiner's comments in the Office action, the Applicant respectfully traverses the rejection of the claims under 35 U.S.C. 103(a) in view of these two references. In particular, the Applicant respectfully submits that BusinessWire and Margaret Quan, alone and in combination, fail to disclose or suggest certain features that are recited in each of the independent claims 1, 13 and 21. Further, the Applicant submits that BusinessWire and Margaret Quan fail to disclose/suggest all of the features of these claims because these references relate to intellectual property asset exchanges, which are an entirely different type of business than that which is the subject of the Applicant's present Application.

Each of the independent claims 1, 13 and 21 recites a method that relates to the transfer of interests in intellectual property between first, second and third parties. More particularly, each of the independent claims 1, 13 and 21 relates to a business method in which ownership rights in intellectual property are first transferred from a second entity to a first entity that is an intermediate entity, and then are transferred from the first entity to a third entity. Claim 21 expressly recites both of such transfers in intellectual property interests as separate method steps, while claims 1 and 13 each expressly recite method steps relating to a single transfer and refer to the second transfer of intellectual property interests in the "wherein" clauses of those claims.

Thus, each of the independent claims 1, 13 and 21 requires an intermediate, first entity (e.g., as termed in the Specification, an "intellectual property investment bank") that receives an intellectual property interest from a second entity and then transfers an intellectual property interest to a third entity. Further, each of the independent claims 1, 13 and 21 recites a method of operation in which the intermediate entity itself actually purchases intellectual property interests and then resells intellectual property interests (or is configured to do so). That is, these claims recite methods in which there are "dual transfers" of interests in intellectual property, first from one outside entity to the intermediate entity, and then from the intermediate entity to another outside entity.

In contrast to pending claims 1, 13 and 21, such dual transfers of interests in intellectual property, first between a second entity and a first entity, and then between the first entity and a third entity, are entirely missing from BusinessWire and Margaret Quan. The Applicant recognizes that BusinessWire and Margaret Quan disclose, respectively,

information regarding The Patent & License Exchange (plx.com) and yet2.com, which are two intellectual property asset exchanges. The Applicant further recognizes that intellectual property asset exchanges generally relate to the transfer of intellectual property. Nevertheless, the Applicant submits that such intellectual property asset exchanges perform methods that are entirely different from the Applicant's claimed methods in that they do not involve dual transfers of interests in intellectual property.

As stated at page 2, line 20 through page 3, line 5 of the present Specification, intellectual property asset exchanges such as The Patent & License Exchange and yet2.com disclosed in BusinessWire and Margaret Quan merely "provide markets or forums in which individuals owning intellectual property assets can place those assets up for licensing or sale." For example, as stated in Margaret Quan, yet2.com merely seeks "to broker intellectual property exchanges deals online". Therefore, while an intellectual property asset exchange constitutes a first entity that facilitates intellectual property transfers between second and third entities, such an exchange does not cause any transfer of intellectual property interests to or from the exchange itself. Rather, the intellectual property asset exchange merely brokers direct transfers of intellectual property interests between the two outside entities.

BusinessWire and Margaret Quan entirely fail to disclose the Applicant's invention as recited in claims 1, 13 and 21 because these references concern a business methodology that is entirely different from the business methodology that is the subject of the Applicant's claims. While the Applicant's claims concern a first, intermediate entity that buys intellectual property assets and then resells them, the intellectual property asset exchanges of BusinessWire/Margaret Quan merely provide services that facilitate transactions between outside parties. Thus, the Applicant's claimed invention is no more similar to the teachings of BusinessWire/Margaret Quan than an investment bank such as Goldman Sachs that buys and resells securities is similar to a stock exchange such as the NASDAQ, which merely provides a forum for the exchange of the securities.

To summarize, therefore, the Applicants submit that independent claims 1, 13 and 21, as well as the remaining claims depending therefrom, are allowable under 35 U.S.C. 103(a) over BusinessWire in view of Margaret Quan because the teachings and suggestions provided by those references are limited strictly to the operations of

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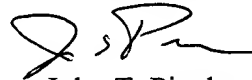
intellectual property asset exchanges, and because these references entirely fail to disclose or suggest the operations of an "intellectual property investment bank" as recited in claims 1, 13 and 21 in which the intermediate entity actually itself purchases and resells the intellectual property being transferred between different outside entities.

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In view of the above Remarks, the Applicant respectfully requests reconsideration and allowance of the present Application.

The Applicant invites the Examiner to telephone the Applicant at the telephone number listed below if discussion with the Applicant would further the prosecution of the present Application, or otherwise be of assistance to the Examiner.

Respectfully,



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